

## Remarks

### Claim Rejections under §112

The Examiner has rejected claims 52 and 58 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Claims 52 and 58 have been canceled and therefore the rejection to these claims is moot. The Applicant has, however, partially included the sample volume limitations of canceled claims 52 and 58 into new claims 59 and 63, respectively, and will be discussed in further detail below.

### Claim Rejections under §102

The Examiner has canceled claims 47-52 and 53-57 under 35 USC §102(b) as being clearly anticipated by Pugh (US Patent 5,736,103).

Claims 47-52 and 53-57 are canceled and thus the rejections to these claims are now moot. Pugh is discussed in detail below in reference to the new claims.

### Claim Rejections under §103

The Examiner has rejected claims 52 and 58 under 35 USC §103(a) as being unpatentable over Pugh.

Claims 52 and 58 are canceled and thus the rejections to these claims are now moot. Pugh is discussed in detail below in reference to the new claims.

### Newly Presented Claims

Applicant has presented new claims 59-66. No new matter has been introduced, and the Applicant believes that the newly presented claims are allowable.

The Applicant notes that the Examiner has cited Pugh and Curry in previous Office Actions rejections based on §102 and §103. Under a 102 rejection, each and every element of the claimed invention must be disclosed in a single prior art reference. Under a §103 rejection, the prior art references must teach or suggest all of the claim limitations.

New independent claims 59 and 63 both include the limitation that the “analyte can be measured from a sample volume of between about .1 microliters to about 2 microliters.”

Pugh does not disclose or suggest a sample volume to be used, and therefore does not disclose or suggest that the “analyte can be measured from a sample volume of between about .1 microliters to about 2 microliters” as required by new claims 59 and 66.

Furthermore, Pugh discloses a disposable hollow frustum, which the Examiner has relied on as a basis that Pugh discloses an optical fiber. A hollow device would not be able to accurately detect an analyte concentration from such a small volume as required by new claims 59 and 66.

Curry (US Patent 4,974,929) as relied on the Examiner, is an invasive sensor and does not disclose any volumes of sample, and particularly not in the volume required in new claims 59 and 66.

The Examiner cited In re Yount and In re Rose for the propositions “that mere size is not ordinarily a matter of invention,” and “the size of the article under consideration which is not ordinarily a matter of invention,” respectively.

The cases are being cited for the proposition that *size* is not ordinary a matter of invention. The cases discuss size in relation to

articles, not volumes of liquids. The size in In Re Yount referred to the size of paper bags, while the size in In Re Rose referred to the size of lumber. The cases would be applicable if the issue were the size of the device in Applicant's claims, namely the micro sensor. However, the smaller the volume of sample provided, the more difficult it may be to accurately quantify an analyte of interest in the sample. Therefore, in the case of medical devices, volume of sample may very well be a matter of invention, as is the case here.

Very respectfully,



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